

REMARKS

Claims 1, 3-5 and 9-14, inclusive, remain in the case, claims 2, 6, 7 and 8 being cancelled by the foregoing amendment. The Applicant has carefully noted each instance of improvident expression, oversight and/or imprecision kindly pointed out by the Examiner and has amended both the specification and the claims to correct these regrettable errors. Moreover the Applicant has further extensively amended each of the claims remaining in the case both to clearly point out the invention and to clearly distinguish the art cited.

The specification has been objected to as including misspellings and oversights. These are regretted and have now been corrected.

Claims 1-8 and 14 have been objected to as improperly reciting means plus function limitations. Again, each of the improvident omissions have been carefully corrected and the means plus function recitations are now each properly expressed.

Claims 1-8 were rejected under 35 USC 112, second paragraph, as failing to point out and distinctly claim the invention. This rejection is respectfully traversed, particularly in light of the foregoing amendments.

In the course of this rejection the Examiner has kindly noted the antecedent imprecisions that regrettably found their way into claims 1, 4 and 8. Each of these have now been carefully corrected, thus obviating the bases for this specific rejection. The oversights are regretted.

Claims 1-14 were rejected under 35 USC 103(a) as obvious from the teachings of the '760 patent to James in view of the teachings of Lerner et al. This rejection is respectfully traversed, particularly in light of the foregoing amendments.

Right at the outset we respectfully note the following text in the at the last partial paragraph of page 4 to the first partial paragraph of page 5 of the instant specification which summarizes the essential distinction over the earlier James patent as follows:

“By selecting a molecular structure of the gas similar to the molecular structures in the adjacent tissue a part of the emitted radiation is then absorbed in the adjacent molecular arrays of the body, raising the excitation levels in the tissue which propagate until a local equilibrium is reached. This equilibrium includes the ambient setting through which the ground return part of the circuit is completed, with the lack of observable radiation then providing an indication that the circuit impedance may be too high, i.e., that the contact skin area may be too dry. In this manner the polar molecules that are associated with all living tissue are included in the circuit lattice responding both to the electrical potential and to the gas emitted radiation.” Specification text, at p 4, l 20 to p 5, l 4.

Thus unlike the prior James patent this circuit relies on a return or ground path through the ambient environment that is more in the nature of the charge dispersal of a static charge rather than a current effect obtained by large ionization potentials. The reduced potentials and ambient return path that then appear throughout the specification are expressed by the propagation avalanche through the tissue which only involve some of the tissue molecules. Thus in distinction to the prior James teachings only a limited molecular involvement is achieved by the reduction in the pulse potential and an increased return path. Lerner et al. neither teaches nor suggests this distinction.

Referring directly to the current claim recitations of each of the independent claims 1, 5 and 9 the following appears:

Claim 1, for example, now recites a limited tissue molecular involvement as follows:

“means for producing an electrical pulsed charge means connected to the free end of said conductor for producing a sequence of electrical charge pulses of an electrical potential relative the ambient charge level sufficient to excite ~~selected ones~~ one or more of the molecules comprising said volume of gas to a higher level of excitation, each said occurrence of ~~energy~~ excitation change producing a discrete electromagnetic pulse.”

Similarly, claim 5 recites:

“means for producing an electrical pulsed charge means connected to the free end of said conductor for producing a sequence of electrical charge pulses of an electrical potential relative the ambient charge level sufficient to excite ~~selected ones~~ one or more of the molecules comprising said volume of gas to a higher level of excitation, each said occurrence of ~~energy~~ excitation change producing a discrete electromagnetic pulse, said means for producing an electrical pulsed charge completing the other part of its circuit across ambient space.”

Claim 9, in turn, recites:

“a planar electrode affixed to the exterior of said chamber in contiguous alignment adjacent said rear wall, said electrode including a conductor connected to one side of said electrical circuit with the other side thereof coupled across ambient space to said tissue, whereby said electromagnetic pulses produced in said chamber are communicated into said tissue.”

Accordingly, all the remaining independent claims recite either the reduced molecular involvement in the tissue, the ambient circuit return path, or both. None of these limitations are found in the art cited.

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The Applicant is mindful that a claimed invention is obvious if the differences between the invention and the prior art

“... are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” *Graham v. John Deere Co.*, 383 U.S. 1, 14, 148 USPQ 459, 465 (1966).

This question of law is based on **factual determinations** that include: (1) the explicit and inherent scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18, 148 USPQ at 467.

The rigor of this factual examination during the prosecution of a patent has had recent attention from our Supreme Court in *Dickinson v. Zurko*, 527 U.S. 150, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999) which concluded that the evidentiary standard is set by the Administrative Procedure Act and reversal is mandated if the ruling is not supported by substantial evidence. Accordingly some evidence needs to exist in the record supporting the conclusion of obviousness, and there must be some teaching in the cited art either suggesting or describing the structure now claimed.

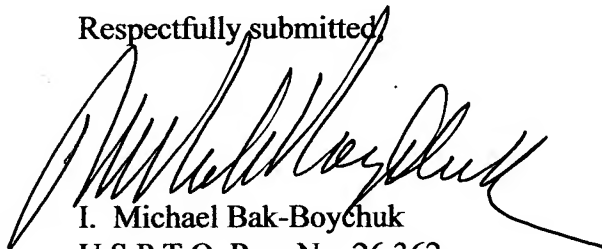
We are also mindful that the Examiner, by the very nature of her profession and exposure, possesses a level of expertise that is at the forefront in the art and matters that the Examiner may deem obvious are not necessarily obvious to those skilled in the art. For these and other reasons the need for record support, and not just the Examiner's expertise, has been particularly focused by the Federal Circuit when it considered *Zurko*

on remand, by specifically demanding a record on appeal on the core issues of patentability, adopting the text from *Baltimore & Ohio R.R. Co. v. Aberdeen & Rockfish R.R. Co.*, 393 U.S. 87, (1966) which states:

“[t]he requirement for administrative decision based on substantial evidence and reasoned findings -- which alone make judicial review possible -- would become lost in a haze of so-called expertise” [393 U.S. at 92]

For all the foregoing reasons, and those articulated earlier in the application text, reconsideration of the instant rejection is respectfully sought.

Respectfully submitted,



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